

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of:	:
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Bahige M. Baroudi <i>et al.</i>	:
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Serial No.: 10/668,862	:
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Filed: September 23, 2003	:
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For: "PIPERAZINE DERIVATIVES	:
USEFUL AS CCR5	:
ANTAGONISTS	:
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Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT & ELECTION OF SPECIES

Sir:

This communication is in response to the Office Action issued on December 5, 2006 in the subject case. A petition for a four-month extension of time is enclosed herewith.

Claims 2, 18, 15-22, 25, and 27-30 are pending in the case. The Examiner restricted the claims into eight groups:

Group I: Claims 2-8, 15-22, 25 and 27, drawn to a method of treatment of solid organ transplant rejection, graft v. host disease, comprising administering to the patient a CCR5 antagonist herein defined, classified in class 514, subclass 252.1+;

Group II: Claims 2-8, 15-22, 25 and 27, drawn to a method of treatment of inflammatory bowel disease, comprising administering to the patient a CCR5 antagonist herein defined, classified in class 514, subclass 252.1+;

Group III: Claims 2-8, 15-22, 25 and 27, drawn to a method of treatment of rheumatoid arthritis, comprising administering to the patient a CCR5 antagonist herein defined, classified in class 514, subclass 252.1+;

Group IV: Claims 2-8, 15-22, 25 and 27, drawn to a method of treatment of multiple sclerosis, comprising administering to the patient a CCR5 antagonist herein defined, classified in class 514, subclass 252.1+;

Group V: Claims 15-22, drawn to a method of treatment of psoriasis, comprising administering to the patient a CCR5 antagonist herein defined, classified in class 514, subclass 252.1+;

Group VI: Claims 15-22, drawn to a method of treatment of atopic dermatitis, asthma, or allergies, comprising administering to the patient a CCR5 antagonist herein defined, classified in class 514, subclass 252.1+;

Group VII: Claims 15-22, drawn to a method of treatment of arthritis not encompassed by invention groups set forth above, comprising administering to the patient a CCR5 antagonist herein defined, classified in class 514, subclass 252.1+;

Group VIII: Claims 28-30, drawn to a composition or kit comprising the CCR5 antagonist herein defined, classified in class 514, subclass 252.1+;

The Examiner additionally required: a) an election of a species, a compound to be examined, and b) identification of the claims encompassing the elected invention.

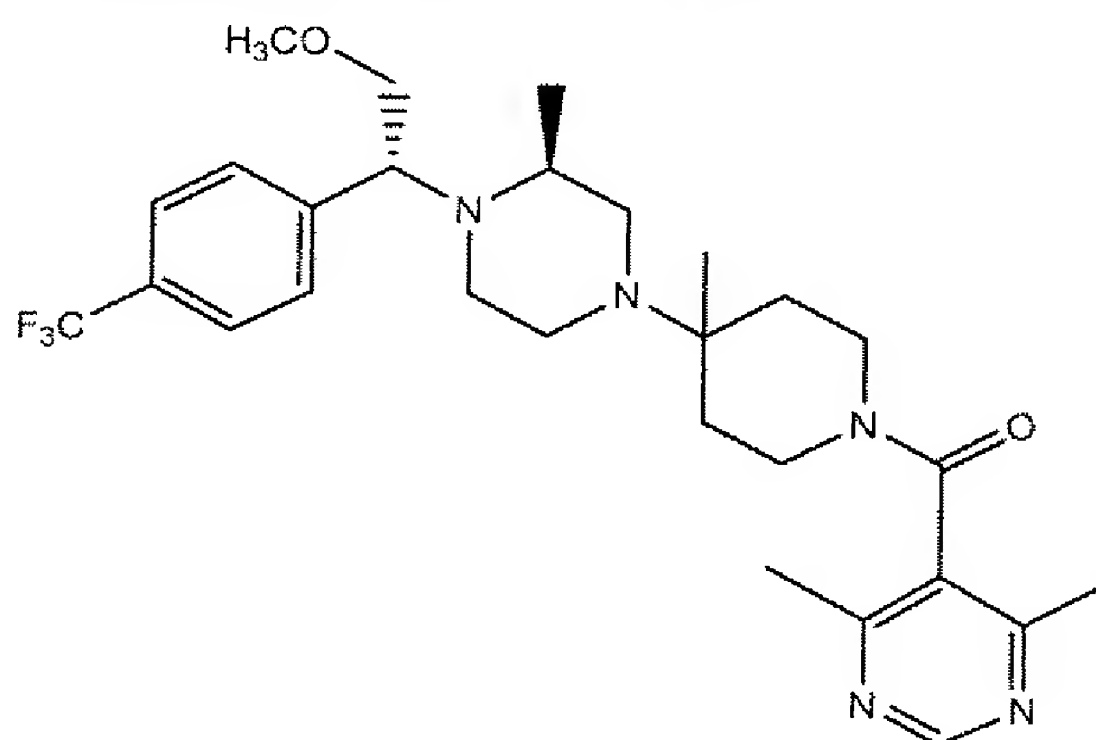
Applicants are puzzled by the restriction into these numerous Groups. Applicants believe that all claims 2-18, 15-22, 25 and 27 form part of one and the same invention. Applicants further believe that when there is a linking claim encompassing the scope of all the processes, uses, composition and compounds, it is inappropriate to restrict the invention into these various inventions. Here, all of the presently restricted groups encompass the same generic structure(s). **Applicants believe that due to such commonality, a complete examination of claims 2-18, 15-22, 25 and 27 would not cause undue burden.** As further evidence, Applicants point out that all of the groups belong to the same class (514) and subclass (252.1+) as shown by the Examiner. Applicants believe that the same art search will in all likelihood apply to the alleged separate inventions, and respectfully submit that the restriction is improper. Even though different method of treatments have been claimed, because they all involved the same generic structure(s), Applicants believe that independent searches would not be required to conduct a patentability search for the different methods of treatment.

Under the statute “two or more independent and distinct inventions.... in one application may.... be restricted to one of the inventions.” Inventions are “independent” if “there is no disclosed relationship between two or more subjects disclosed” (MPEP 802.01). The term “distinct” means that “two or more subjects as disclosed are related.... but are capable of separate manufacture, use or sale as claimed, and are patentable over each other” (MPEP 802.01). However, even when patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

In the present application, Applicant believes that the Examiner has not established a clear reason to establish the existence of any of the above seven groups. Reconsideration and withdrawal of the restriction requirement are, therefore, respectfully requested. The Examiner is requested to at least combine groups I-VII, and examine them in one application.

Furthermore, in order to comply with the Examiner’s requirement, Applicant is electing, with traverse, the invention cited as Invention Group No. I by the Examiner. Additionally, in order to comply with the requirement that a species be elected for examination purposes, Applicant is electing compound of Example 29 A on page 89 of the specification, viz.,




The claims encompassing the elected invention are: claims 2-8, 15-22, 25, and 27.

If the Examiner has questions, the Examiner is invited to contact the undersigned.

April 24, 2007
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